

REMARKS

In the Office Action¹, the Examiner took the following actions:

1. rejected claims 7-9 under 35 U.S.C. § 112, first paragraph;
2. rejected claims 7-9 under 35 U.S.C. § 112, second paragraph;
3. rejected claim 7 under 35 U.S.C. § 102(b) as being anticipated by JP 2001-043631 to Nishimura ("*Nishimura*");
4. rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over *Nishimura* in view of U.S. Patent No. 5,991,504 to Hori ("*Hori*"); and
5. rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over *Nishimura* in view of Official Notice.

By this Amendment, Applicant has amended claims 7-9 for clarification and to more appropriately define the invention. The amendments to the claims are fully supported by the original disclosure. See, e.g., specification, p. 17, ll. 3-7.

In view of the foregoing amendments and the following remarks, Applicant respectfully traverses the rejections and requests reconsideration and allowance of the pending claims.

Rejection of Claims 7-9 under 35 U.S.C. § 112, First Paragraph

The Office rejected claims 7-9 under 35 U.S.C. § 112, first paragraph, asserting that "[t]he specification does not support for the same area which have remaining capacity equal to [] zero and is extended as being recited [in] claims 7-9." Office Action, p. 2. Applicant respectfully traverses this rejection. For example, the specification

¹ The Office Action may contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

discloses that in “the case where the remaining capacity of the still picture recording area ARS has become equal to zero . . . the video recording area ARV is assigned to the still picture recording area ARS . . . thereby making it possible to extend the still picture recording area ARS.” Specification, p. 16, ll. 11-16, (emphases added). See, also, e.g., p. 16, l. 21 - p. 17, l. 7, p. 18, ll. 4-8, and p. 21, ll. 4-11.

Therefore, Applicant respectfully submits that claims 7-9 are supported by the specification, and thus requests that the Examiner reconsider and withdraw the rejection of claims 7-9 under 35 U.S.C. § 112, first paragraph.

Rejection of Claims 7-9 under 35 U.S.C. § 112, Second Paragraph

Applicant respectfully traverses the rejection of claims 7-9 under 35 U.S.C. § 112, second paragraph. However, solely to advance prosecution, Applicant has amended claims 7-9 for further clarification. Applicant respectfully submits that amended claims 7-9 are definite, and thus requests that the Examiner reconsider and withdraw the rejection of claims 7-9 under 35 U.S.C. § 112, second paragraph.

Rejection of Claim 7 under 35 U.S.C. § 102(b)

As a preliminary matter, Applicant respectfully notes that the Office has not properly cited to the reference. 37 C.F.R. § 1.104(c)(2) states, “[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified” (emphasis added). The Office did not explain with specificity how the *Nishimura* anticipates each and every element of Applicant’s claimed invention. For this

reason, Applicant respectfully requests that the Office explain the pertinence of the reference to the claim elements with specificity should the claims be rejected on the same ground in the next action.

Notwithstanding the above, Applicant respectfully traverses the rejection of claim 7 under 35 U.S.C. § 102(b) as being anticipated by *Nishimura*. In order to properly establish that *Nishimura* anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). *Nishimura* does not disclose each and every element of Applicant's claimed invention.

Independent claim 7, as amended, calls for a combination including "compare[ing] the remaining capacity of the other one of the first and second recording areas with a predetermined extension size" and "if the remaining capacity of the other one of the first and second recording areas is larger than the predetermined extension size, assign[ing] an area having a size equal to the predetermined extension size in the other one of the first and second recording areas to the one of the first and second recording areas where the remaining capacity has become equal to zero to thereby extend the one of the first and second recording areas." *Nishimura* fails to teach at least these elements.

The Office asserted that *Nishimura* teaches "extend[ing] the one area." See Office Action, pp. 3-4. Without acquiescing to this assertion, Applicant respectfully

submits that *Nishimura* nevertheless does not teach comparing the remaining capacity of one area with a predetermined extension size and assigning an area having a size equal to the predetermined extension size in the one area to another area. In view of this, *Nishimura* fails to teach the above-noted elements recited in claim 7. Accordingly, *Nishimura* cannot anticipate claim 7, and claim 7 is allowable.

Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 7 under 35 U.S.C. § 102(b).

Rejection of Claim 8 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claim 8 under 35 U.S.C. § 103(a) as unpatentable over *Nishimura* in view of *Hori*. A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. ... [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). ... The factual inquiries ... [include determining the scope and content of the prior art and] ... [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Claim 8 depends from claim 7, and thus include all the elements thereof. As discussed above in regard to the rejection under 35 U.S.C. § 102(b), *Nishimura* fails to teach at least “compare[ing] the remaining capacity of the other one of the first and second recording areas with a predetermined extension size” and “if the remaining capacity of the other one of the first and second recording areas is larger than the predetermined extension size, assign[ing] an area having a size equal to the predetermined extension size in the other one of the first and second recording areas to the one of the first and second recording areas where the remaining capacity has become equal to zero to thereby extend the one of the first and second recording areas,” as recited in claim 7 and included in claim 8. The Office asserted that *Hori* “teaches a boundary of the areas.” Office Action, p. 5. Even if this assertion is correct, which Applicant does not concede, *Hori* also fails to teach or suggest the above-noted elements, and thus does not compensate for the deficiencies of *Nishimura*.

Therefore, for at least this reason, the Office has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 8. Moreover, there is no motivation for one of

ordinary skill in the art to modify the teachings of the reference to achieve the claimed combination. Thus, no reason has been clearly articulated as to why claim 8 would have been obvious to one of ordinary skill in the art in view of the prior arts.

Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 8, and the Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 8 under 35 U.S.C. § 103(a).

Rejection of Claim 9 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claim 9 under 35 U.S.C. § 103(a) as unpatentable over *Nishimura* in view of Official Notice. A *prima facie* case of obviousness has not been established.

First, Applicant respectfully traverses the Examiner's apparent reliance on personal knowledge by Official Notice. M.P.E.P. § 2144.03(C) states "[i]f the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding" (emphases added). Further, M.P.E.P. § 2144.03(A) states, "[o]fficial notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances . . . [o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." Because the Examiner appears to be asserting Official Notice based on personal knowledge, Applicant requests the Examiner provide documentary evidence as required by the M.P.E.P. should any rejection be maintained in the next official communication based

on Official Notice. In addition, Applicant asserts that it is not old and well known to cause recording areas to undergo padding.

Notwithstanding the above, even if the Office Notice is taken, which Applicant does not concede to be appropriate, the Office Notice does not teach or suggest at least “compare[ing] the remaining capacity of the other one of the first and second recording areas with a predetermined extension size” and “if the remaining capacity of the other one of the first and second recording areas is larger than the predetermined extension size, assign[ing] an area having a size equal to the predetermined extension size in the other one of the first and second recording areas to the one of the first and second recording areas where the remaining capacity has become equal to zero to thereby extend the one of the first and second recording areas,” as recited in claim 7 and included in claim 9. Therefore, the Official Notice also fails to overcome the deficiencies of *Nishimura*.

Therefore, for at least this reason, the Office has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 9. Moreover, there is no motivation for one of ordinary skill in the art to modify the teachings of the reference to achieve the claimed combination. Thus, no reason has been clearly articulated as to why claim 9 would have been obvious to one of ordinary skill in the art in view of the prior arts.

Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 9, and the Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 9 under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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